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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,234	02/02/2001	Harri Holma	944-003.054	8148

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WARE FRESSOLA VAN DER SLUYS &  
ADOLPHSON, LLP  
BRADFORD GREEN BUILDING 5  
755 MAIN STREET, P O BOX 224  
MONROE, CT 06468

EXAMINER

ELALLAM, AHMED

ART UNIT	PAPER NUMBER
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2662

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/776,234

Applicant(s)

HOLMA ET AL.

Examiner

AHMED ELALLAM

Art Unit

2662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This communication is responsive to the Amendment filed on January 28, 2004.

The Amendment has been entered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grilli et al, US (6,438,117) in view of Willars, US (6,597,679).

Regarding claim 1, Grilli with reference to figures 4B, 8 and 9, discloses an inter-operator handover in a mobile telecommunications network comprising a first operator of a first sub-network operated in a code division multiplex access and having a plurality of first radio coverage areas, see figure 8; and a second operator of a second sub-network operated in a radio frequency in accordance with the Global System for Mobile Communications (GSM) mode having a plurality of second radio coverage areas partly overlapping with the first radio coverage areas, see figure 8, areas 1-5, wherein the handover is performed for a mobile terminal (40, figure 4B) of the first operator between the first and second operators when the mobile terminal is located in an overlapped section of the first coverage areas and the second coverage areas, see

figure 8, areas 1-5, see also column 13, lines 22-43, the method comprising the steps of:

- prior to initiating handoff Mobile station is triggered for searching CDMA frequencies of neighboring cells, see column 24, lines 66-67 and column 25, lines 1-8, (corresponding to claimed providing a first list of first radio coverage areas visible to the mobile terminal for allowing the mobile terminal to access the first radio coverage areas through the first sub-network when the mobile terminal moves into the first coverage areas);

- providing the mobile station with a list of the frequencies of neighboring GSM cells, see column 17, lines 16-44. (Corresponding to providing a second list of second radio coverage areas to the mobile terminal for allowing the mobile terminal to access the second coverage areas through the second sub-network when the mobile terminal is located in the second coverage areas beyond the first coverage areas).

While Grilli discloses inter-operator handoff between CDMA and GSM systems, he does not disclose a handoff between inter-operator handoff between WCDMA and GSM system.

However, Willars in the same field of endeavor, and with reference to figure 2, discloses an inter-operator handover between a GSM and WCDMA system, see also column 6, lines 4-24.

Therefore, it would have been obvious to an ordinary person of skill in the art, at the time the invention was made to make the inter-operator handover of Willars in the Grilli environment so that inter-operator handoff can be applied in WCDMA/GSM hybrid

system, while taking advantage of the fast searches for the candidate base station that the neighbors list can assist in determining for handoff.

Regarding claim 10, claim 10 is a means claim that have the same scope of method claim 1, thus it is subject to the same rejection.

Regarding claims 2 and 11, Grilli discloses that the handoff is carried out during a call. See column 13, lines 22-43. ( Claimed the second list is provided when the mobile terminal is operated in a connected mode).

Regarding claims 3 and 12, Grilli discloses that handoff is carried out during idle mode, see column 15, lines 28-38. (Corresponding to claimed second list is provided when the mobile terminal is operated in idle mode).

Regarding claims 5, 11 and 14, Grilli discloses a BSC (Base Station Controller) that provides the mobile station 40 with a list of frequencies of GSM neighboring cells. See column 17, lines 37-44. ( Claimed first list is provided by a BSC of the second sub-network).

Regarding claim 13, Grilli discloses a BSC (Base Station Controller) that provides the mobile station 40 with a list of frequencies of GSM neighboring cells. See column 17, lines 37-44. ( Claimed first means is located in a radio network controller of the first sub-network).

Regarding claims 4, 6, 7, 15 and 16. Grilli does not disclose that the lists are provided by either the BSC or RNC as indicated in claims 4,6, 7, 15 and 16. However, Examiner takes official notice that neighbor lists provisioning by either a base station controller or radio network controller are well known in the art, it would have been

obvious to an ordinary person of skill in the art to provide the neighbor lists in Grilli network using either BSC or RNC as a design choice.

Regarding claims 8, 9, 17 and 18, Grilli discloses that the list is updated as the mobile moves from one cell to another and it is maintained during handovers between GSM and CDMA base stations. (that reads on the limitations of claims 8, 9, 17 and 18).

### ***Response to Arguments***

2. Applicant's arguments filed January 28, 2004 have been fully considered but they are not persuasive.

Applicants' argument focused on the content of the preambles of the independent claims 1 and 10. However, in these claims, the preamble is not given a patentable weight, because the body of the claims does not rely on the preamble to define the inter-handover process. Examiner further note that the main claimed subject matter consists of the provisioning to a mobile station of neighbor lists (or lists) for handoff purpose. It is to be noted that List provisioning for handoff control is widely known technique in wireless cellular system. And as set forth in the rejection, the combination of Grilli et al, US (6,438,117) and Willards et al, US (6,597,679) disclose Applicants' invention as claimed. Examiner therefore believes that maintaining the rejection above is proper.

***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (703) 308-6069. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kizou Hassan can be reached on (703) 305-4744. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHMED ELALLAM  
Examiner  
Art Unit 2662  
16 March 2004



HASSAN KIZOU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600